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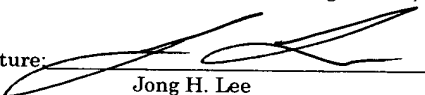
**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant(s) : Holger LISTLE et al.
Appl. No. : 10/600,894
Filed : June 20, 2003
For : DRIVER INFORMATION DEVICE
Art Unit : 3661
Examiner : Thu V. NGUYEN
Conf. No. : 5906

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Jong H. Lee

**APPELLANTS' REPLY BRIEF IN RESPONSE TO
EXAMINER'S ANSWER (UNDER 37 C.F.R. § 41.41)**

SIR :

In response to the Examiner's Answer (hereinafter the "Answer") mailed on November 21, 2006, regarding the above-identified application, Applicants submit the following arguments in support of the appeal of the final rejection.

ARGUMENT

The issue presented for review in this case is whether claims 15-18 are being unpatentable under 35 U.S.C. § 103(a) over U.S. Patent Application Publication No. 2002/0130906 ("Miyaki") in view of U.S. Patent Application Publication No. 2003/0085910 ("Noble"), U.S. Patent No. 6,640,185 ("Yokota") and U.S. Patent Application Publication No. 2002/0145632 ("Shmueli"). Applicants respectfully submit that the combination of Miyaki, Noble, Yokota and Shmueli does not render obvious the subject matter of claims 15-18, for at least the following reasons.

To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Independent claim 15 recites, in relevant parts, "a map display, special objects being represented on the map display by **special object symbols**, a **common indicator symbol** in the map display **indicating a presence of corresponding multiple special objects** one of (a) in one location and (b) within a preselected radius of a location, **a selection of the common indicator symbol enabling a display of a selection menu** containing **information about the corresponding multiple special objects**, wherein the selection menu is displayed on the map display; wherein during the display of the selection menu, the **common indicator symbol is displayable at a same location on the map** where it was displayed before the display of the selection menu, **embedded in the selection menu.**"

On p. 6, 1. 1-9 of the Answer, the Examiner contends that "[p]resenting the multiple icons in a specific data arrangement known in the arts . . . is a matter of preferences; the matter of preference can be detected from the specification of the present application because . . . the present application also teaches an obvious modification method of presenting the multiple icons, namely fading out the common indicator symbol during operator selection and replacing the common indicator symbol with the multiple icons on the map

(specification page 5, lines 21-23).” This is a completely absurd argument: the Examiner is contending that the **Applicants’ claimed invention is a matter of preference because Applicants disclosed the invention in the specification** (page 5, lines 21-23 of Applicants’ specification discusses an alternative embodiment of the invention). However, it is fundamental rule of U.S. patent law that the Applicants’ own description of the invention in the specification cannot be used to support an obviousness rejection. (See, e.g., MPEP 2143, citing In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)). For at least this reason, the Examiner’s argument is completely flawed.

Independent of the above, to the extent the Examiner contends on p. 6, l. 9-12 of the Answer that “[t]he method of presenting the multiple icons as disclosed by the present invention in page 5, lines 21-23 is exactly the same as the method . . . [disclosed] in Miyaki (Miyaki para. 0045),” Applicants note that the Examiner’s reliance on a specific embodiment disclosed in the specification, rather than analyzing the specific claim limitations of the appeal claims, is completely flawed. As noted above, a fundamental criterion for establishing obviousness is that the prior art references must teach or suggest all of the ***claim limitations***. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). The claim limitation specifically discussed by Applicants on page 7, last paragraph, of the Appeal Brief is the feature that **the common indicator symbol is displayed at the same place in the map and embedded in the selection menu**, and Applicants once again note that Miyaki clearly does not teach this feature, but in fact teaches away from this claimed feature. Accordingly, the Examiner’s statement that “[t]he method of presenting the multiple icons as disclosed by the present invention in page 5, lines 21-23 is exactly the same as the method . . . [disclosed] in Miyaki (Miyaki para. 0045)” is completely irrelevant, at best.

Independent of the above, Applicants note that the Examiner is ignoring the actual claimed language and focusing on a specific, alternative embodiment discussed in the specification, in order to overcome the obvious deficiency of Miyaki, i.e., Miyaki clearly does not teach this feature, but in fact teaches away from this claimed feature. Even if such focus on a specific embodiment disclosed in the specification were somehow proper (which it is not), the specific embodiment (on page 5, lines 21-23) cited by the Examiner is not the specific disclosure cited by Applicants in the “Summary of Claimed Subject Matter” section of the Appeal Brief; instead, Applicants clearly indicated that p. 4, l. 28-29, and p. 5, l. 3 of the Specification supported the claimed feature that “during the display of the selection menu, the

common indicator symbol is displayable at a same location on the map where it was displayed before the display of the selection menu, **embedded in the selection menu.**”

Accordingly, the Examiner’s reliance on the specific disclosure of p. 5, l. 21-23 of Applicants’ specification, i.e., the statement that “[t]he method of presenting the multiple icons as disclosed by the present invention in page 5, lines 21-23 is exactly the same as the method . . . [disclosed] in Miyaki (Miyaki para. 0045),” is completely flawed in the context of the present obviousness analysis.

Independent of the above, to the extent the Examiner contends that “Miyaki does not teach away from arranging the multiple icons in well-known menu format, Miyaki just teaches one format of data arrangement of the multiple icons among many available format of data arrangement,” Applicants note that the Examiner cannot selectively ignore the teachings of the prior art that is unfavorable to the Examiner’s position; instead, all the teachings of the prior art must be considered, including those which teach away from the claimed invention. (See MPEP 2143.01.II).

With respect to the teachings of Noble, although the Examiner continues to assert that “Noble clearly teaches displaying the common indicator symbol 102 (Fig. 2) at the same place on the map when the menu 106 is presented,” (Answer, p. 7, l. 5-6), the specification of Noble clearly indicates that 102 and 106 are not common-indicator icons; instead, Paragraph [0042] of Noble clearly indicates that 102 represents “cluttered symbols,” and 106 is merely an expanded display of the cluttered symbols 102.

With respect to the teachings of Shmueli, the Examiner continues to contend that “the idea of arranging the menu at the common indicator symbol is clearly suggested by Shmueli (Fig. 6, paragraph 0053),” (Answer, p. 7, l. 8-9), the actual disclosure of Shmueli clearly contradicts the Examiner’s assertion: paragraph 0053 of Shmueli indicates that element 86 shown in Fig. 6 is a “launch button,” not a common indicator symbol. Furthermore, to the extent the Examiner contends that the “Shmueli also suggests the motivation for displaying the menu 86; 88, 90, 92 (Fig. 6) at the same location of the common indicator symbol 86 . . . in the last 6 lines of paragraph 0053,” i.e., “by providing the menu at the location of the selectable indicator 86 (Fig. 6) with the selectable indicator 86 (Fig. 6) embedded in the menu, the data arranging format provides the user ability to access the functions listed in the menu and at the same time allowing the user to see the information surrounding the menu . . . on the small area

of the display,” (Answer, p. 7, l. 10-16), this alleged “motivation” is a complete figment of the Examiner’s imagination: the last six lines of paragraph 0053 of Shmueli merely indicate that “the launching bar 76 may provide a user interface to the functions provided by the key 10 as well as the fixed advertising medium to hold advertising information or select advertising information independent of the web page selected by the user.” Accordingly, there is not even a shred of evidence that the motivation for providing the launch button 86 has anything to do with “the small area of the display,” as alleged by the Examiner.

Independent of the above, to the extent the Examiner contends that “by using the map display feature taught by Noble the user can obtain the result ‘displaying the menu with the common indicator at the same location on the map where it was displayed’ by just simply moving the menu location because in claim 11 Noble discloses that the list of the symbol expansion graphics . . . are ‘movable by the user’ . . . ; therefore, . . . it is obvious that the user can move the menu to anywhere he prefers on the map display,” (Answer, p. 7, l. 22 – p. 8, l. 5), Applicants note that these contentions are completely flawed. First, regarding the limitation that “during the display of the selection menu, the **common indicator symbol is displayable at a same location on the map** where it was displayed before the display of the selection menu, **embedded in the selection menu**,” Applicants note that this limitation is a part of a device claim, i.e., claim 15 recites a “driver information device” including “a map display,” and the claimed limitation regarding the display of the common indicator symbol further defines the “map display.” It is a fundamental rule of U.S. patent law that actions of human being cannot substitute for a part of the claimed structure. See Transmatic Inc. v. Gulton Indus., 35 U.S.P.Q.2d 1027, 1035 (Fed. Cl. Ct. 1994) (citing Brown v. Davis, 116 U.S. 237, 249 (1886)). Furthermore, there is no reasonable interpretation of the claim, particularly when read in light of the present specification, that would support the Examiner’s contention that a manual repositioning of the menu location is something that is encompassed by the claimed feature. In addition, the fact that it is theoretically possible that human intervention could achieve the limitation recited in the claim does not support the obviousness conclusion: to the extent the Examiner may be relying on the doctrine of inherent disclosure in support of the obviousness rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Accordingly, the fact that a claimed feature may result doesn't support an obviousness conclusion.

On page 8 of Applicants' Appeal Brief, Applicants noted that Yokota merely teaches displaying a selection menu instead of a map, and therefore the idea that one of ordinary skill in the art would actually incorporate the teachings of Yokota selectively to arrive at an arrangement in which **"during the display of the selection menu, the common indicator symbol is displayable at a same location on the map** where it was displayed before the display of the selection menu, **embedded in the selection menu,"** is completely negated by the overall teachings of Yokota. In response to the Applicants' argument, the Examiner states in the Answer that "Yokota does not teach this limitation, however, Miyaki, Noble, and Shmueli teach the limitation," and that "[o]ne cannot show nonobviousness by attacking references individually where the rejections are based on combination of references." Applicants note that it is impossible to discuss a combination of references without discussing the teachings of individual references, and this fact is clearly evidenced by the Examiner's own discussions of the teachings of individual references.

To the extent the Examiner contends that Yokota's teachings of displaying a selection menu instead of a map does not teach away from the present claimed feature that **"during the display of the selection menu, the common indicator symbol is displayable at a same location on the map** where it was displayed before the display of the selection menu, **embedded in the selection menu,"** Applicants note that the Examiner's rationale is flawed. To the extent that the Examiner states that Yokota does not teach away from the claimed feature because "Yokota [merely] teaches one more available alternative," (Answer, p. 8, l. 23 – p. 9, l. 1), this assertion is nothing more than an attempt by the Examiner to selectively ignore the teachings of the prior art that is unfavorable to the Examiner's position, which attempt is clearly contrary to the well-established rule that all the teachings of the prior art must be considered, including those which teach away from the claimed invention. (See MPEP 2143.01.II).

In addition to the above, to the extent the Examiner contends that "the teachings of Yokota match the teaching in page 5, lines 12-14 of the specification of the present application in which selected information can obviously [be] displayed on either the map or on a separate screen," (Answer, p. 9, l. 2-4), the Examiner is once again impermissibly ignoring

the actual claim limitation, and instead focusing on the specific disclosure in the specification. As noted above, a fundamental criterion for establishing obviousness is that the prior art references must teach or suggest all of the **claim limitations**. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). The claim limitation at issue is the feature that **the common indicator symbol is displayed at the same place in the map and embedded in the selection menu**, and Applicants once again note that Yokota clearly teaches away from this feature. The fact that Applicants' specification may disclose an alternative arrangement has no bearing on what the claimed feature is, and whether the prior art teaches away from the claimed feature.

In an attempt to minimize the unfavorable disclosure of Yokota, i.e., the fact that Yokota teaches away from the present claimed feature that “**during the display of the selection menu, the common indicator symbol is displayable at a same location on the map** where it was displayed before the display of the selection menu, **embedded in the selection menu**,” the Examiner contends that “the examiner does not rely on Yokota on this limitation.” (Answer, p. 9, l. 9). However, it is entirely irrelevant whether the Examiner is relying on Yokota for this particular limitation: to the extent the Examiner is citing Yokota in support of the obviousness rejection, the overall teachings of Yokota must be considered, including those teachings which teach away from the asserted combination, not just the specific teachings that are favorable to the Examiner's conclusion. (See MPEP 2143.01.II).

On page 9, l. 10-22 of the Answer, the Examiner contends that “de-cluttered symbol taught by Noble is analogous to the common indicator symbol 13 (Fig. 1) of the present application.” However, this assertion is completely contradictory to the Examiner's assertion made throughout the prosecution of the present application and repeated in the Answer, i.e., the Examiner has consistently argued that cluttered symbol 102 (see, e.g., parag. [0042], line 2 of Noble, “cluttered symbols 102”) is the common indicator symbol: “Noble teaches displaying the selection symbol 102 (Fig. 2) in the same location on the display.” (Answer, p. 3, l. 16-17).

Furthermore, to the extent the “Examiner directs attention to the definition of ‘cluttered symbols’ and ‘de-cluttered symbols’ of Noble as provided in paragraphs 0018 and 0021,” (Answer, p. 9, l. 12-13), Applicants note that nothing in paragraphs 0018 and 0021 of Noble supports the Examiner's contention. Paragraphs 0018 and 0021 of Noble merely indicate that a “de-cluttered” symbol may identify a single entity with an underlying hierarchy,

and that “[a]s the operator zooms out the display,” thereby viewing the map at a different level of abstraction, “otherwise cluttered symbols can be **replaced** with a de-cluttered symbol.” Accordingly, it is clear that the switching between the de-cluttered symbol and any corresponding cluttered symbols occurs as a function of a change in the zoom level of the map, i.e., the level of abstraction of the map, and therefore it is impossible for the map display to simultaneously display the de-cluttered symbol together with any corresponding cluttered symbols. For this reason alone, the teachings of the cited sections of Noble clearly teach away from the present claimed invention.

In summary, while the Examiner has assembled a selective combination of elements disclosed in Miyaki, Yokota, Noble and Shmueli, there is simply no objective suggestion to make the specific combination asserted by the Examiner, and the actual overall teachings of the applied references negate any suggestion for combining the selected teachings in the manner asserted by the Examiner. In an effort to overcome this glaring deficiency, the Examiner has resorted to repeated assertions of “obvious modification” and “obvious design choice,” but the Examiner has failed to provide any objective evidence to support the assertions “obvious design choices.”

For at least the foregoing reasons, Applicants respectfully submit that claim 15 and its dependent claims 16-18 are not rendered obvious by the overall teachings of Miyaki, Noble, Yokota and Shmueli.

CONCLUSION

For the preceding reasons, it is respectfully submitted that the rejections of claims 15-18 under 35 U.S.C. § 103(a) should be reversed.

While no fees are believed to be due in connection with this paper, the Office is authorized to charge any fees deemed necessary in connection with this paper to Deposit Account No. 11-0600 of Kenyon & Kenyon LLP.

Respectfully submitted,

 (R. No. 36,197)

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By: SONG LEE for Gerard Messina
Gerard A. Messina
Reg. No. 35,952
KENYON & KENYON LLP
One Broadway
New York, NY 10004
(212) 425-7200

CUSTOMER NO. 26646